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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/454,865	12/07/1999	SHINICHIRO TANIGUCHI	104934	4339

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EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 03/29/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/454,865

Applicant(s)

TANIGUCHI ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 12/30/2003, the following **claims 1-27** are presented for examination.

2. The amendments to the specifications, filed on 12/30/2003, have been considered.

2.1 In response to the amendments filed on 12/30/2003, the objection to claims 1, 4, 5, 18, and 19 due to minor informalities has been withdrawn and the rejection to claims 9, 11, and 15 under *35 USC § 112*, Second Paragraph has been withdrawn.

2.1 Applicant's arguments, see pages 22-25, filed on 12/30/2003, with respect to the rejection of claims 1-27, under 35 USC 103 (a) have been fully considered but they are not persuasive.

Applicant states that the license generator writes information into the license but does not read the information. The Office Action does not state that the license generator reads the information, but does recite a reading part that reads information as claimed by Applicant and as cited (see column 8, lines 35-67) in the rejected claim 1. Information can be added, removed, upgraded, etc. also, in column 7, lines 20-25 Misra shows type of information that can be stored or read in a license pack. Applicant also mentions that Misra does not disclose a storing part in the data carrier. Examiner respectfully states that Misra discloses a license pack that stores distribution information for example (see column 7, lines 20-25) in addition to (column 8, lines 35-67) in the Office Action.

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Regarding claim 18, Applicant also argues that Misra does not disclose that the license server stores information and disclose or suggest a data carrier that stores distribution information of the article generated for each one or set of transactions in the distribution process of the article and at least a part of a signature value of at least part of a piece of the distribution information. As stated in the Office Action (columns 15-16), the license server updates and stores information for example, (see column 15, lines 25-28) that recites “the license server adds a record to the client assignment table...” and in (column 9, lines 36-61) Misra discloses that the tables are related. Further in column 16, lines 56 -67 Misra discloses that the license server upgrades a record in the table.

Regarding claim 21, Applicant states that Misra does not disclose or suggest a distribution information management module that reads/stores the information out/in a data carrier attached to an article. Examiner respectfully asserts that Misra discloses or suggests reads/stores information in the data carrier as discussed above. Also as stated in the Office Action, the granting module (126) and the authenticating module (128) perform the functions of upgrading the license pack (see for example column 11, lines 25-35) and they also communicate information to other units for processing information to manage information relative to the article. Office Action also recites (128, 134); see an example of related functions column 12, lines 8-38. As stated in the Office Action, in the rejected claim 1, the arrangement of the modules disclosed by Misra does not prevent them from performing the functions disclosed in claim 21.

Examiner respectfully maintains the rejection of claims 1-27 under *35 USC § 103* in view of Misra et al..

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.1 **Claims 1-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,189,146 to **Misra et al.**

3.2 **As per claim 1, Misra et al.** substantially teaches a distribution information management system (see column 10 and figure 3) having a structure comprising a license pack that meets the recitation of a data carrier attached to an article for storing the information of the article, the distribution information processing module comprising: a reading part, storing part (see column 8, lines 35-67), a first communication part that communicates with the distribution information management module (figure 3, numbers 124, 126), a first information verification unit comprising a first part that verifies the information read out from the data carrier a first verification key storage part that stores the verification key used by the first information

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verification part for verification of the information (see column 8, lines 35-67), and a license server (28) that meets the recitation of an information generating unit that processes the information to be stored in the data carrier comprising: a distribution information generating part that generates the information to be stored in the data carrier; a signature module (26,118) that performs signature generating process; a signature key storage part (100,120) that stores the signature key information used by the signature module for generating a digital signature; a signature key information selection part (26); that selects a signature key information stored in the signature key storage part and a signature key information acquisition part (124) that acquires the signature key information from the distribution information management module, the signature module comprising: a signature part that generates a digital signature for the information generated by the distribution information generating part; and a first signer private information storage part that stores signer private information used by the signature part for generating a digital signature (column 10, lines 4 et seq.); the distribution information management module comprising: a second communication part (128,134) that communicates with the distribution information processing module; a second information verification unit that processes the information received comprising: a second information verification part that verifies the information received from the distribution information processing module; and a second verification key storage part that stores the verification key used by the second information verification part for verification of the information (see column 11, lines 25-65); and a signature key information generating unit that processes the signature key information to be sent to the distribution information processing module comprising: a signature key information generating part (28,128) that generates a signature key information used by the distribution

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information processing module for generating a distribution information, a signature key storage part (110) (see also column 11, line 65 through column 12, lines 27) a signer private information selection part (132) that selects signer private information used by the signature key information generating part for generating signature key information; and a second signer private information storage part that stores the signer private information (136) (see also column 11, line 65 through column 12, lines 27). Not disclosed is the way the structure is arranged. However, **Misra et al.** discloses all the functions pertained to the parts in the claim. To shift location of parts requires routine skill in the art-*In re Japikse* 86 USPQ 70 (CCPA 1950). To one skilled in the art, it is obvious that the functions of the parts in the claims are found in the invention of **Misra et al.** without departing from the spirit and scope of the invention of **Misra et al.** Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the system of **Misra et al.** to provide a module with structures arranged differently. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Misra et al.** so as to present a modified module.

As per claim 2, Misra et al. discloses the limitation wherein the signature module is detachable from the distribution information processing module. The installer generates the signature in the license server that can separate from the server (see column 5).

As per claim 3, Misra et al. discloses the limitation wherein the signature module is tamperproof (see column 8, lines 35-52 and column 11, lines 55-60).

As per claim 4, **Misra et al.** discloses the limitation wherein the information generating unit has a signature key use limit information storage part, the signature key information selection part does not select signature key information used more than a specified number of times for signature (column 7, lines 1-20). **Misra et al.** does not mention not selecting signature key information but discloses preventing users from multiplying the number of licenses purchased on the same server. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Misra et al.** to prevent copying of licenses.

As per claim 5, **Misra et al.** discloses the limitation wherein the signature key use limit information storage part is disposed in the signature module (column 7, lines 1-20). **Misra et al.** does not mention disposing signature key information but discloses preventing users from multiplying the number of licenses purchased on the same server. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Misra et al.** to prevent copying of licenses.

Claim 6 has the same limitation as claim 1 except for adding a second reading and storage part in the information generating module. **Misra et al.** discloses a license server (28) that meets the recitation of an information generating unit that can read, store the information in the data carrier.

Claim 7 has the same limitation as claim 1 except for adding a third communication part. **Misra et al.** discloses many communications part between the units (see figure 3): a second communication part (128) and a third communication part (134). Therefore, **claim 7** is rejected on the same rationale as the rejection of **claim 1**.

As per **claim 8**, **Misra et al.** discloses the claimed system of claim 1 capable of combining the storage parts from figure 3. As it is apparent to one skilled in the art, to have the verification key stored in the first verification key storage part and the second verification key storage part common for all the distribution information processing modules and distribution information management modules does not depart from the scope and spirit of the invention of **Misra et al.** (see column 5).

As per **claim 9**, **Misra et al.** discloses the claimed system of claim 1 capable of combining the information verification parts from figure 3 to perform the same process since the parts are implemented in computers. As it is apparent to one skilled in the art, to have the information verification parts performing the same process does not depart from the scope and spirit of the invention of **Misra et al.** (see column 5).

As per **claim 10**, **Misra et al.** discloses the limitation wherein the first information verification unit has a first verification key selection part (114) that selects the verification key used by the first information verification part (see column 8, lines 35-67).

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As per claim 11, Misra et al. discloses the limitation wherein the second information verification unit has a second verification key selection part that selects the verification key used by the second information verification part. **Misra et al.** further discloses many verification parts that select verification keys (see columns 6, 14-17).

As per claim 12, Misra et al. discloses the limitation wherein the signature key information generating unit has a signature key selection part that selects a signature key (column 15, line 65 through column 16, line 37).

As per claim 13, Misra et al. discloses the limitation wherein the information stored in the data carrier comprises at least a product identifier, a signer identifier, a receiver identifier, and a signature value, and which information is stored as one unit (see tables 1-5 and column 15, line 37 through column 16, line 37). To one skilled in the art, the content of the field disclosed by **Misra et al.** can be varied in any way into one unit without departing from the scope and spirit of the invention of **Misra et al.**

As per claim 14, Misra et al. discloses the limitation wherein the information stored in the data carrier contains at least a verification key identifier, and which information is stored as one unit (see tables 1-5 and column 15, line 37 through column 16, line 37).

As per claim 15, Misra et al. discloses the limitation wherein the information stored in the data carrier contains at least a distribution information management module identifier, and

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which information is stored as one unit (see tables 1-5 and column 15, line 37 through column 16, line 37).

As per claim 16, Misra et al. discloses separate units of signature values stored (see figure 3). **Misra et al.** further discloses the limitation wherein the information stored in the data carrier contains at least a product identifier, a signer identifier, and a receiver identifier and which information is stored as one unit and the information has a signature value separately from the information for unit (see tables 1-5).

As per claim 17, Misra et al. discloses the limitation wherein the information stored in the data carrier contains at least a product identifier, a signer identifier, a receiver identifier, and a verification key identifier and which information is stored as one unit, and the information has a signature value corresponding to the verification key identifier for each verification identifier (see tables 1-5). **Misra et al.** discloses signature for different parts and further authenticates the requests when verifying information (see columns 13-15).

3.3 **As per claim 18, Misra et al.** discloses the limitation of distribution information generated for one set of transaction stores in a data carrier and a signature value of the distribution information (see columns 15-16).

As per claim 19, Misra et al. discloses the limitation wherein the distribution information of the article contains at least the identifier of the article, the identifier of the

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receiver who received the article, and the identifier of the signer who generates the signature value (see tables 1-5 and columns 15-16).

3.4 **Claims 20-23** are similar to the rejected **claim 1** except for incorporating the claimed system into a module and a method. Therefore, **claims 20-23** are rejected on the same rationale as the rejection of **claim 1**.

3.5 **Claims 24-25** have the same limitation as the rejected **claim 1** except for incorporating the claimed system into a computer program product. Therefore, **claims 26-27** are rejected on the same rationale as the rejection of **claim 1**.

3.6 **Claims 26-27** have the same limitation as the rejected **claim 1**. Therefore, **claims 26-27** are rejected on the same rationale as the rejection of **claim 1**.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. US Patent 2001/0018660 Satou

This patent pertains to an admission system where the transactions are stored in a card.

b. US Patent 6,539,360 Kadaba

This patent pertains to a method and system for protecting packages to afford special handling shipped to various destinations.

c. US Patent 6,285,916 Kadaba et al.

This patent pertains to a delivery tracking system to track parcels during delivery.

4.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

March 16, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100